

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/111,454 07/08/98 BEN-PORATH

A 49959-013

WM31/0213

EXAMINER

MCDERMOTT WILL & EMERY  
600 13 STREET NW  
WASHINGTON DC 20005

BALI, V

ART UNIT PAPER NUMBER

2623

DATE MAILED:

02/13/01

*13*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>09/111,454</b>	Applicant(s) <b>Ben-Porath et al</b>
	Examiner <b>Vikkram Bali</b>	Group Art Unit <b>2623</b>

Responsive to communication(s) filed on Dec 28, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-3, 6-8, 18-20, 23-25, 35-38, and 40-48 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-3, 6-8, 18-20, 23-25, 35-38, and 40-48 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2623

**DETAILED ACTION**

1. This is in response to applicant's amendments received on 12/28/00, all requested changes to claims have been entered. And, the rejections under 35 USC 102 are withdrawn.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2623

3. Claims 1-3, 6-8, 18-20, 23-25, 35-38, 40-42 and 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takagi et al. (US 5801965) in view of Broude et al. (US 5814829).

With respect to claims 1-3, 6-8, 18-20, 23-25, 35-38, 40-42 and 46-47 the rejections are respectfully maintained and incorporated by references as set forth in the prior office action (paper # 9). For claims 1, 18, and 37 see the rejection for the claims 4-5, 21-22 and 39, because the limitations of claims 4-5, 21-22 and 39 are incorporated into claims 1, 18 and 37.

4. Claims 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takagi et al. (US 5801965) and Broude et al. (US 5814829) as applied to claim 38 above, and further in view of Shahar et al (US 5591971).

With respect to claims 43-45 the rejections are respectfully maintained and incorporated by references as set forth in the prior office action (paper # 9).

5. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takagi et al. (US 5801965) and Broude et al. (US 5814829) as applied to claim 46 above, and further in view of Tsuchiya et al (US 5960106).

With respect to claim 48 the rejections are respectfully maintained and incorporated by references as set forth in the prior office action (paper # 9).

Art Unit: 2623

***Remarks***

6. In the amendment filed at 12/28/2000, applicant argued that:

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 19880; *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, .

In this specific case, Takagi's method and system for manufacturing semiconductor devices and method and system for inspecting semiconductor devices, inspects the wafer and classifies the defects, and Broude's teachings of having a counter for counting the defects and annunciating a signal if the counter goes over a predetermined threshold. It will be obvious for one in the ordinary skilled in the art to combine the two to form a inspecting system that will have a classification counter and does annunciates if counter exceeds the predetermined threshold, this will provide an apparatus that will either complete the process or cease the process (see col. 2, lines 10-15).

Art Unit: 2623

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vikkram Bali whose telephone number is (703) 305-4510.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Art Unit: 2623

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 306-5406 (for formal communications intended for entry)

(703) 306-5406 (for informal or draft communications, such as proposed  
amendments to be discussed at an interview, please label "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two,

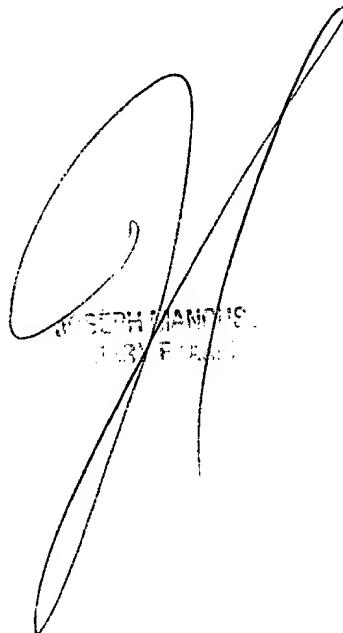
2121 Crystal Drive,

Arlington, VA.

Sixth Floor (Receptionist).

vb

February 7, 2001

  
JOSEPH MANDIS  
JULY 12 2001